

## REMARKS

This is a full and timely response to the outstanding final Office Action mailed December 13, 2007. Reconsideration and allowance of the application and pending claims are respectfully requested.

### **I. Claim Rejections - 35 U.S.C. § 112, First Paragraph**

Claims 1-5, 12, and 13 have been rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors had possession of the claimed invention at the time the application was filed.

The purpose of the written description requirement of 35 U.S.C. § 112, first paragraph, is to ensure that the inventor had *possession*, as of the filing date of application relied upon, of the specific subject matter later claimed by him. *Application of Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976); *Application of Edwards*, 568 F.2d 1349, 1351, 196 USPQ 465, 467 (CCPA 1978). This possession requirement ensures that the applicant actually invented the later claimed subject matter at the time the patent application was filed. As stated by the Court of appeals for the Federal Circuit (hereinafter "Federal Circuit"):

Satisfaction of the description requirement ensures that subject matter presented in the form of a claim subsequent to the filing date of the application was sufficiently disclosed at the time of filing so that a *prima facie* date of invention can fairly be held to be the filing date of the application.

*Eiselstein v. Frank*, 52 F.3d 1035, 1039, 34 USPQ 2d 1467, 1470 (Fed. Cir. 1995). With possession being the key to satisfying the written description requirements of 35 U.S.C. § 112, first paragraph, the test for establishing that adequate written description simply concerns showing evidence that such possession existed. As has been repeatedly stated by both the Court of Customs and Patent Appeals and the Federal Circuit:

[A]ll that is required is that it [the applicant] *reasonably conveyed* to persons skilled in the art that, as of the filing date thereof, the inventor had *possession* of the subject matter later claimed by him.

*Eiselstein*, 52 F.3d at 1039, 34 USPQ2d 1467, 1470 (emphasis added). See also, *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1158, 47 USPQ2d 1829, 1832 (Fed. Cir. 1998) ("To meet this requirement, the disclosure of the earlier application, the parent, must reasonably convey to one of skill in the art that the inventor possessed the later-claimed subject matter at the time the parent application was filed"); *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991) ("The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter."); *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (If adequate description support exists, the application relied upon "reasonably conveys to the artisan that the inventor had possession at the time of the later claimed subject matter."). This legal precedent makes it clear that it is well-established, indeed axiomatic, that, to comply with written description requirement of 35 U.S.C. § 112, first paragraph, all that is required is that

applicant "reasonably convey" to persons having ordinary skill in the art that, as of the filing date, the inventor possessed the subject matter at issue.

In the present case, Applicant clearly had possession of the claimed "automatically performing an automated remote proofing". As described by Applicant in paragraph 0027, an "automated preflight" is performed by a "preflight program". The preflight program is described as helping "automate" the process of ensuring that a file is ready to print as intended by a designer. As for the limitation "comparing said job ticket with the obtained device configuration information", Applicant directs the Examiner's attention to paragraph 0027 in which Applicant states that the preflight program "reviews the document specifications and compares them to the device characteristics at the PSP". Regarding the limitation "checking said print job and said job ticket for errors", Applicant directs the Examiner's attention to paragraph 0028 in which Applicant state that the preflight program "checks to determine whether some of the common errors normally found during the prepress stage at the PSP are present in the print job."

In view of the above, it is clear that Applicant possessed the concept of "said automated preflight module automatically performing an automated remote proofing by (i) comparing said job ticket with the obtained device configuration information to determine whether all required elements for successful processing of said print job are present and (ii) checking said print job and said job ticket for errors". Regarding the Examiner's identification of paragraph 0033, in which Applicant describes a designer proofing a document, Applicant notes that there is no reason to assume that the automated remote proofing does not occur simply because manual proofing is performed. As noted above, Applicant disclosed that the automated preflight module

"helps" to automate the process. *Applicant's specification*, paragraph 0027. Therefore, proofing is performed by the automated preflight module *and then by the designer*. By performing the automated proofing, the number of problems or errors that the designer must deal with may be reduced.

Applicant respectfully requests that the rejections be withdrawn.

## **II. Claim Rejections - 35 U.S.C. § 103(a)**

Claims 1-6, 8-10, and 12-15 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lavery, et al.* ("Lavery," U.S. Pat. No. 6,429,947) in view of *Schorr, et al.* ("Schorr," U.S. Pat. No. 6,608,697) and *Lahey, et al.* ("Lahey," U.S. Pat. No. 6,587,217). Applicant respectfully traverses.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden 35 U.S.C. § 103 to establish obviousness by showing objective teachings in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). The key to supporting an allegation of obviousness under 35 U.S.C. § 103 is the clear articulation of the reasons why the Examiner believes that claimed invention would have been obvious. See MPEP § 2141. As stated by the Supreme Court, "[r]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR v. Teleflex*, 550

U.S. at \_\_\_\_, 82 USPQ2d at 1396 (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)) .

In the present case, the Examiner has not established that Applicant's claims are obvious in view of the prior art. Applicant discusses those claims in the following.

Applicant's independent claim 1 provides:

1. A method of managing workflow in a commercial printing environment including a designer location and a print service provider location, said method comprising:

creating at the designer location a print job to be printed by the print service provider location;

creating a job ticket at the designer location that specifies production devices of the print service provider to be used to process said print job and processing instructions for the print service provider location;

an automated preflight module at the designer location automatically establishing a link to the print service provider location and obtaining updated device configuration information from the print service provider location concerning the production devices specified in said job ticket;

said automated preflight module automatically performing an automated remote proofing by (i) comparing said job ticket with the obtained device configuration information to determine whether all required elements for successful processing of said print job are present and (ii) checking said print job and said job ticket for errors;

generating at the designer location a press ready file that encapsulates both said print job and said job ticket;

submitting said press ready file to the print service provider location via an electronic network; and

performing at the print service provider least one of automated printing, finishing, packaging and shipping using said press ready file.

In the final Office Action, the Examiner argued that Lavery discloses "generating at the designer location a press ready file that encapsulates both said print job and said job ticket". For support of that position, the Examiner cites column 10, lines 50-61 of the Lavery reference, which provide as follows:

FIG. 3 shows a block diagram 300 of a generalized series of steps used in creating a print order. A customer 302 contacts a web site via the computer 304. The customer inputs data on the web site according to data prompts needed to generate the customer's desired print job. The system creates a Print Ready File (PRF), as shown in element 305. The PRF 306 is shown to the customer 302 for on-screen proofing 308 of various elements comprising the product. Once the order is approved, step 310 shows the order being sent to the printer. The PRF 306 is thereafter sent to printer as a print order 312, and the manufacturing (or printing) process begins.

As can be readily appreciated from the above excerpt, Lavery does not in fact describe any "job ticket" or state that such a job ticket is "encapsulated" along with a print job in a press ready file. Although Lavery identifies a Print Ready File, Lavery does not state that it encompasses a print job and a job ticket.

In the final Office Action, the Examiner acknowledged that Lavery does not disclose "an automated preflight module at the designer location automatically establishing a link to the print service provider location and obtaining updated device configuration information from the print service provider location concerning the

production devices specified in said job ticket". To account for that shortcoming, the Examiner turned to the Schorr reference, which was alleged to disclose that limitation. Applicant disagrees.

As a first matter, Schorr does not disclose an automated preflight module at the designer location "automatically establishing a link to the print service provider location". Regarding column 3, lines 61-67 and column 4, lines 29-37 of the Schorr reference, which were identified by the Examiner, those portions of Schorr's disclosure describe a preflight system 101 that print vendors 117 and a print buyer 119 can use. Schorr does not state, however, that the preflight system 101 automatically establishes a link to the print vendors 117. Furthermore, the preflight system 101 is clearly not "at the designer location". As shown in Figure 1, the preflight system 101 is separate from the print buyer 119 and his client machine 121. Schorr also explicitly states that the preflight system 101 is embodied on one or more servers. *Schorr*, column 3, lines 51-58. Although Schorr describes discrete modules contained within the preflight system 101 that are downloaded to the client machine 121, Schorr does not state that the entire preflight system is downloaded to that machine.

As a second matter, Schorr does not actually disclose an automated preflight module "obtaining updated device configuration information from the print service provider location concerning the production devices specified in said job ticket". Column 6, lines 41-65 of the Schorr reference, which were cited by the Examiner, say nothing about a production device "specified in said job ticket". Indeed, Schorr does not even mention a job ticket.

The Examiner further acknowledged in the final Office Action that Lavery does not disclose "said automated preflight module automatically performing an automated remote proofing by (i) comparing said job ticket with the obtained device configuration information to determine whether all required elements for successful processing of said print job are present and (ii) checking said print job and said job ticket for errors". To account for that shortcoming, the Examiner again turned to the Schorr reference, which was alleged to disclose that action. Applicant disagrees.

Regarding the automated preflight module "automatically performing an automated remote proofing by comparing said job ticket with the obtained device configuration information to determine whether all required elements for successful processing of said print job are present", Applicant notes that Applicant explicitly claimed that the automated preflight module is located "at the designer location". Schorr's analyzer 111, which is described in column 3, lines 10-29 cited by the Examiner, is not located at the designer location. Instead, the analyzer 111 is located on one or more servers separate from the print buyer 119 and his client machine 121. *Schorr*, column 3, lines 51-58. Applicant further notes that, although Schorr describes downloading various modules to the client machine 121, the analyzer 111 is not one of them. As a further matter, Applicant notes that the analyzer is not described as comparing a "job ticket" with obtained device configuration information. Instead, the analyzer 111 is merely described as comparing "document elements" with information listed in a printer profile.

Schorr further does not actually disclose an automated preflight module automatically performing an automated remote proofing by "checking said print job and




said job ticket for errors". Again, as mentioned above, Schorr does not discuss job tickets.

In view of the above, it is clear that the applied references do not render Applicant's claim 1 or its dependents obvious. Applicant submits that independent claim 6 and its dependents are also non-obvious for similar reasons.

### CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

  
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David R. Risley  
Registration No. 39,345